

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CLARK EQUIPMENT COMPANY, d/b/a
BOBCAT COMPANY,

Opposition No. _____

Opposer,

v.

TTAB

UNOVA INDUSTRIAL
AUTOMATION SYSTEMS, INC.

Applicant.

NOTICE OF OPPOSITION

BOX TTAB - FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

In the matter of the application for registration of the trademark BOBCAT ("Applicant's Mark") for metal working machines and machine tools, namely horizontal machining centers to machine metal workpieces ("Applicant's Goods"), Serial No. 78/121,669, filed April 15, 2002, by Unova Industrial Automation Systems, Inc. ("Applicant"), and published for opposition in the Trademark Official Gazette of March 22, 2005, Clark Equipment Company, a Delaware corporation d/b/a Bobcat Company a Delaware corporation of West Fargo, North Dakota believes that it would be damaged by registration of the mark shown therein and opposes the same of these grounds:

1. Since long prior to Applicant's filing date, Clark Equipment has used the trade name and trademark BOBCAT on and in connection with a wide variety of goods and services. Clark Equipment is the owner of, *inter alia*, the following trademarks incorporating or comprising the mark BOBCAT and United States registrations therefor:

04/27/2005 ZC LIFT01 00000104 78121669

01 FC:6402

300.00 OP

04-25-2005

U.S. Patent & TMO/TM Mail Rcpt Dt. #72

- a. BOBCAT, U.S. Reg. No. 2,027,135 issued on December 31, 1996, for parts manuals; owners manuals; service manuals; and parts catalogs in the field of industrial machines and products in International Class 16;
- b. BOBCAT, U.S. Reg. No. 1,741,160 issued on December 22, 1992, for offroad vehicles in International Class 12;
- c. BOBCAT, U.S. Reg. No. 1,661,108 issued on October 15, 1991, for repair services for mobile, industrial, construction and excavating machinery; rental services for machinery; namely, rental of skid steer loaders, articulated front end loaders, back hoes, trenchers and excavators in International Class 37;
- d. BOBCAT, U.S. Reg. No. 1,677,100 issued on February 25, 1992, for instruction services in the field of operation and repair of mobile machinery in International Class 41;
- e. BOBCAT, U.S. Reg. No. 1,651,245 issued on July 23, 1991, for hydraulic, hydrostatic and transmission fluid for off-road machinery in International Class 1;
- f. BOBCAT, U.S. Reg. No. 1,622,595 issued on November 13, 1990, for towels in International Class 24;
- g. BOBCAT, U.S. Reg. No. 1,605,240 issued on July 10, 1990, for motor vehicle lubricants, namely, motor oil in International Class 4;
- h. BOBCAT, U.S. Reg. No. 1,620,865 issued on November 6, 1990, for hand tools - namely, shovels, scrapers, rakes and post hole diggers in International Class 8;
- i. BOBCAT, U.S. Reg. No. 1,622,185 issued on November 13, 1990, for batteries for off-road machinery in International Class 9;

- j. BOBCAT, U.S. Reg. No. 1,577,764 issued on January 16, 1990, for cylinder seals and o-rings for use in industrial machines in International Class 17;
- k. BOBCAT, U.S. Reg. No. 1,604,367 issued on July 3, 1990, for attachments for skid steer loaders - namely backhoes, rotary brooms, landscape rakes, hydraulic breakers, grapples and combination buckets; machinery - namely, trenchers, excavators, skid steer loaders, articulated front end loaders, backhoes, and parts therefor; ignition tune-up kits, including rotors, condensers, points and spark plugs; excavator customer maintenance kits, namely, belts, light bulbs, fuses, digging teeth, bolts, motor oil and hydraulic fluid; filters for machinery - namely, hydraulic fluid filters, engine oil filters and air filters; remanufactured engines, remanufactured starters; remanufactured alternators; remanufactured hydraulic pumps; and remanufactured hydraulic motors in International Class 7;
- l. BOBCAT, U.S. Reg. No. 1,598,690 issued on May 29, 1990, for clothing, namely gloves and caps in International Class 25;
- m. BOBCAT, U.S. Reg. No. 1,153,505 issued on May 5, 1981, for rental of skid steer loaders in International Class 42;
- n. BOBCAT, U.S. Reg. No. 890,034 issued on April 28, 1970, for propelled vehicle having front end mounting means for various attachments actuated by the power means of said vehicle in International Class 12;
- o. BOBCAT, U.S. Reg. No. 670,566 issued on December 2, 1958, for backhoes for attachment to trucks, tractors, trailers and the like, and parts therefor in International Class 23.

Clark Equipment has complied with the requirements of Sections 8 and 15 of the Trademark Act such that Reg. Nos. 2,027,135; 1,741,160; 1,661,108; 1,677,100; 1,651,245; 1,622,595; 1,605,240; 1,620,865; 1,622,185; 1,577,764; 1,604,367; 1,598,690; 1,153,505; 890,034; and 670,566 are incontestable and constitute conclusive evidence of Clark Equipment's exclusive right to use the mark BOBCAT in commerce on or in connection with the goods and services specified in said registrations and related goods and services. The other registrations owned by Clark Equipment constitute prima facie evidence of Clark Equipment's exclusive right to use the mark BOBCAT in commerce on or in connection with the goods and services specified in said registrations.

3. Clark Equipment has continuously used the BOBCAT mark on and in connection with the goods and services recited in paragraph two above since the date of first use identified in those registrations and is still using the BOBCAT mark in interstate commerce.

4. In addition, Clark Equipment has for decades done business under the name BOBCAT such that BOBCAT constitutes its trade name and trademark.

5. Clark Equipment has expended substantial time, effort, and money promoting its BOBCAT mark and name for four decades, and as a result, BOBCAT is now and was prior to Applicant's filing date a strong and famous source-identifier of Clark Equipment.

6. Applicant's Mark BOBCAT is identical to Clark Equipment's incontestable BOBCAT mark.

7. Applicant's Goods are related to those offered by Clark Equipment on and in connection with the BOBCAT mark.

8. Clark Equipment's BOBCAT mark and products and services sold and rendered there under are famous and well-known among consumers and the public generally. Consumers and other customers of Clark Equipment for its goods and services sold under the BOBCAT

mark are also the customers and intended customers for Applicant's Goods intended to be sold under Applicant's Mark.

9. The parties' goods are likely to be advertised in the same media and sold through some of the same trade channels.

10. Trademark licensing is a an established business practice. Many trademark owners license their marks to be used on products and services that they do not themselves make or sell.

11. As a result of the foregoing facts, customers for Applicant's Goods sold under Applicant's Mark would be likely to be confused, mistaken, and deceived as to whether Applicant's Goods originate with or are sponsored, authorized, or licensed by Clark Equipment, all to Clark Equipment's damage. In addition, Applicant's intended use and registration of its mark on or in connection with its goods is likely to dilute the distinctive value of Clark Equipment's famous BOBCAT mark.

12. Due to Clark Equipment's priority as to its use of the BOBCAT mark and the likelihood of confusion and dilution alleged above, Applicant is not entitled to the registration sought and said registration, if allowed, would be a source of injury and damage to Clark Equipment. Priority is not in issue given Clark Equipment's federal registrations referenced herein.

13. Applicant does not have Clark Equipment's consent to use or register Applicant's Mark.

WHEREFORE, Clark Equipment requests that this opposition be sustained and the registration sought by Applicant be refused. Enclosed herewith is a check in the amount of \$300.00 in payment of the requisite fee. Charge or credit Deposit Account No. 13-3080 with any

shortage or overpayment of the fees associated with this communication. This document is being submitted in triplicate.

Dated this 20th day of April 2005.

MICHAEL BEST & FRIEDRICH LLP
Attorneys for Opposer

By: 
Dyann L. Kostello
Lori S. Meddings

P.O. Address

Michael Best & Friedrich LLP
100 East Wisconsin Avenue, Suite 3300
Milwaukee, Wisconsin 53202-4108
Phone: (414) 271-6560
Fax: (414) 277-0656

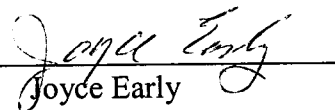
Atty. Ref. No.: 017267/9002/9340

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to:

United States Patent and Trademark Office
Trademark Trial and Appeal Board
Attention: TTAB BOX FEE
P O Box 1451
Alexandria, VA 22313-1451

on this 20 day of April 2005.


Joyce Early

Date: 4-20-05

T:\clienta\017267\9002\A1137031.1